

(b.2) Provisional double patenting rejection with respect to 10/031,776: In 10/031,776 only the point that is being pressed ever changed its state, and a point changes state only by being switched on (never off). This kind of behaviour is typical of the classical “stones on grid” games (e.g. Othello, GO). In the current application, the pressed point is not affected, and points that are affected are only switched off, never switched on. In addition, the current application has the two patterns and their application, and in the context of 10/031,776 these don’t make any sense, and therefore are not obvious. Put another way, of the five elements that were listed in (c.2) of the argument in the appeal brief, only element (e) appears in the claims of 10/031,776. From all of these reasons, the current application is very non-obvious with respect to 10/031,776.

(b.3) Provisional double patenting rejection with respect to 10/031,890: In 10/031,890, points are never switch off, only on or reverse their colour. In the current application, the only change is switching off. That is not an obvious change, because “adding stones” (i.e. switching on points) is the way most people think about these games. Nevertheless, this case is quite close because both use the idea of two patterns that switch each turn. I will file a terminal disclaimer for this one (it is not obvious to me at the moment when I should do that).

(c) Responses to rejection under 35 USC 103 based on Weiner in view of Lites Out!

(c.1) On top of page 7 it says that “.. 2 players are not claimed..”. That is true, because “two players” is an intention to use that cannot be patented. However, Claim 5 generates an interesting two-player game by the fact that the “current player colour” switches each press, and therefore which pattern affects which colour switches each press.

(c.2) To make it clear, assume colours Red and Green, and currently “current player colour” is Red. When the first player presses a point, the “current player” pattern is applied to the “current player colour”, i.e. Red, and then the “current player colour” changes to Green.. When next the second player presses a point, the “current player” pattern now applies to Green, and the “current player colour” is set again to Red. Now the first player plays again, and this cycle repeats until the end of the game. Therefore, for the first player, “his” colour, i.e. the colour that the “current player” pattern applies to when he presses a point, is Red, while for the second player, “his” colour is Green. The same is true, but in reverse, for the “opponent player” pattern, and hence the “opponent” colour. Thus the first player perceives Red to be his colour and Green to be his opponent’s colour, and the second player perceives Green as his colour and Red as his opponent’s colour. The players’ perception of course cannot be claimed. What is claimed is the two patterns, their dependency on the “current player colour”, and the switching of the “current player colour”, which in combination cause the perception.

(c.3) On top of page 7 the it also says it is not claimed “... using different patterns for the two colours for the two different players.” “Two different players” is intention to use. Two different patterns for two colours *is* claimed. As I explained in section (a) above, I made it now explicit. Note that the association of patterns with colours is not fixed, but switches around after each press, as described above in (c.2).

(c.4) On page 8 there is argument against the non-obviousness of the elements that I listed, but if anything the argument shows that they are non-obvious.

(c.5) (a) Using different patterns for the two colours: This is now made explicit in the amended claims as discussed in (a) above.

(c.6) (b) Switching the pattern between the colours in each turn (point press): This is argued against with a reference to specific text in Weiner *et al*. However, there is nothing about switching patterns in each point press or switching them between the colours in the text that is referred to in Weiner *et al*, or indeed anywhere in Weiner *et al* or Lites Out!. Thus this element is clearly novel. The text that the examiner refers to also does not make it obvious to switch the patterns, either between the colours or in each turn, as there is nothing there (or anywhere in Weiner *et al* or Lites Out!) that points in this direction. As discussed in (c.2) above, this element is what makes the behaviour an implementation of a two-player game (with the “declaration” of winner, element (e)).

(c.7) (c) The changes are only switching off of points: I didn’t understand the argument against this one. It seems to argue that switching a point off changes its colour, therefore changes in colour can be called switching off, and hence the changes in Weiner *et al* or Lites Out! can be regarded also as switching off only. This does not make sense to me, but I cannot think of a better interpretation. In Weiner *et al* and Lites Out! there are always changes in both directions, so this element does not appear in them. It is not obvious because within the setting of Weiner *et al* and Lites Out! it will make a game that is far too simple, as it will simply switch off all the points in very few moves. Note that element (c) has never appeared until now anywhere except in the current application, which shows it is quite non-obvious.

(c.8) (d) The game ends when there are illuminated points only in one colour (and because points are only switched off, most of the points are switched off): This is argued against by “Switching off of a point changes its colour”. That is clearly not a reasonable argument, and doesn’t show that the element appears in Weiner *et al* or Lites Out! in any way or that the element is obvious.

(c.9) I suspect there may be a misunderstanding here of what Claim 5 says. The text in Claim 5 is (italics added) “when all the points *that are illuminated* are illuminated in the same colour ...”. It seems that the examiner may have interpreted it to mean that *all* the points are illuminated in the same colour. As I tried to make clear in the text in parenthesis (above in (c.8) and in the original text in the brief), not all the points are illuminated at this stage of the game. In fact, because points are only switched off during the game, most of points will be switched off, and only few points will still be illuminated in one of the colours. That is not the same as “all points in the same colour”.

(c.10) If we accept the insistence of the examiner that switching off a point “changes its colour”, then the board I describe has three colours: two illuminated colours (let’s call them Red and Green) and one unilluminated colour (Grey). With this terminology, the termination condition is “when all points are either (Grey or Green) or (Grey or Red)...”. There is nothing in Weiner *et al* or in Lites Out! that is even close to such a termination condition. Thus using this terminology makes it clear that element (d) is not obvious in Weiner *et al* or Lites Out.

(c.11) (e) The colour of the illuminated points in the end is the winner: No argument is presented. This element doesn’t make sense at all in the context of Weiner *et al* and Lites Out!.

(c.12) Thus of the five elements, none is actually found Weiner *et al* or in Lites Out!, alone or in combination, and none of them is obvious.

(c.13) On page 9 it continues to discuss “with respect to (d) and (e) above,..”, but does not point to any occurrence of these elements. What it says is :”Weiner *et al* also states that the objective is to go from a starting configuration of indicator states to desired configuration of indicator states (Column 2, 54-56)”. That is nothing like the current application, where the termination condition is not a configuration at all. The actual configuration in the end is of no interest whatsoever. It is only which colour are the points that are still illuminated.

(c.14) The example that is given (all point are lit) is an obvious configuration, but again, it is not the termination condition of the current application (see in (c.10) above), and neither is “all points off”. Thus this still doesn’t show elements (d) and (e), and does not make them less non-obvious.

(c.15) It then continues that “Weiner *et al* are very open...”, but saying that there are “other possible ending configuration” does not make it obvious to use an ending which is not a configuration (it does not even make obvious using any specific configuration, unless this specific configuration is itself obvious). As explained above, the termination condition in the current application is not a configuration, because the location(s) of the point(s) that are still illuminated (or the Red or Green points in the terminology of (c.10)) is immaterial.

(c.16) In the middle of p. 9 it says: ”Applicant states that the elements make little or no sense at all since the references used are not set up for two players games. However two players are not claimed.” The latter argument is not to the point. The question whether an element makes sense in the context of Weiner *et al* with Lites Out! is not dependent on what else I claim. It is dependent only on the element and the text of Weiner *et al* and Lites Out! (and the state of the art).

(c.17) It then says: ”Weiner discloses in 6:45-55 that two players may play the game”. What Weiner *et al* disclose in 6:45-50 is one person playing a full game from starting configuration to end configuration, and then another player playing. However, this method of playing and, importantly, all the other ideas that appear in this paragraph do not make any of the elements (a)-(e) more obvious, and therefore it is irrelevant to the discussion here.

(c.18) Summary: None of the 5 elements (a)-(e) which were discussed above (and listed in paragraph (c.2) of the argument in the appeal brief) appears in Weiner *et al* with Lites Out!. Apart from (c) they are clearly non-obvious with respect to Weiner *et al* and Lites Out!, and even (c) is not actually obvious. Their combination is very non-obvious, and in the context of the devices and programs of Weiner *et al* and Lites Out! doesn’t make sense, because the latter are not set up for two-players games.

Thanks,

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